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Commissioner of Patents and Trademarks
Box Patent Application
Washington, DC 20231

"Express Mail" Receipt No. AB132289817

Date of Deposit March 15, 1999

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Box Patent Application, Washington, DC 20231.

Jennifer D. Ahearn
Jennifer Ahearn

Subject: Transmittal of Application for United States Letters Patent
Attorney Docket No. 31045-7

Dear Sir:

Transmitted herewith for filing is the patent application of:

Inventor: ALBERT J. SILVERA

Entitled: TECHNIQUE FOR DECORATING A SHOE AND
A SHOE DECORATED USING THE TECHNIQUE

The filing fee has been calculated as shown below:

| | No. Filed | No. Extra | Small Entity | | Other Than Small Entity | |
|-------------------------------|-----------|-----------|--------------|----------|-------------------------|----------|
| Basic Fee | | | | \$380.00 | | \$760.00 |
| Total Claims | 20 - 20 = | 0 | x \$9= | 0 | x\$18= | |
| Ind. Claims | 2 - 3 = | 0 | x \$39= | 0 | x\$78= | |
| ___ Multiple Dependent Claims | | | 0+\$130= | 0 | +\$260= | |
| TOTAL | | | | | | \$760.00 |

Enclosed are the following:

1. 12 pages of specification, claims and abstract;
2. 3 pages of informal drawings;
3. Originally Executed Declaration and Power of Attorney;
4. Originally Executed Assignment with Form PTO-1595;
5. Petition to Make Special;
6. Information Disclosure Statement and PTO-Form 1449;
7. 13 Cited references;
8. Check in the amount of \$130.00 for Petition to Make Special;
9. Check in the amount of \$760.00 to cover filing fees; and
10. Check in the amount of \$40.00 to cover recordation fees.

The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 13-3735. A duplicate copy of this sheet is enclosed.

- ☒ Any additional filing fees required under 37 C.F.R. 1.16.
- ☒ Any patent application processing fees under 37 C.F.R. 1.17.

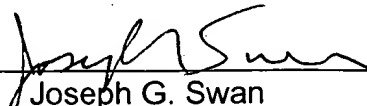
It is respectfully requested that the Commissioner accord the enclosed patent application a filing date and serial number.

Respectfully submitted,

MITCHELL, SILBERBERG & KNUPP LLP

Dated: March 15, 1999

By


Joseph G. Swan
Registration No. 41,338

Certificate of Mailing Under 37 C.F.R. § 1.10

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Jennifer Ahearn

Atty. Docket No. 31045-7

PATENT

Jc530 U.S. 03/15/99

09/268412



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Albert J. Silvera

Serial No.: Not Yet Assigned

Filed: Herewith

For: Technique for Decorating a Shoe
and a Shoe Decorated Using the
Technique

Group Art Unit: To Be Assigned

Examiner: To Be Assigned

PETITION TO MAKE SPECIAL

Commissioner of Patents and Trademarks
Box Patent Application
Washington, DC 20231

Sir:

Applicant hereby petitions to make special the above-referenced Patent
Application. Applicant believes that this application is directed to a single invention.

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Applicant has caused a pre-examination search regarding the invention to be made. Specifically, the search was conducted in Class 36, Subclasses 45 and 136, and in Class 40, Subclass 636. The following patents turned up in this search. A copy of each patent is attached to this Petition.

U.S. Patent 4,852,276 (Savoca) discusses a shoe which includes a frame for holding an insert which is imprinted with a design or logo. As understood by Applicant, in Savoca the insert is held in place by the lip of the frame, as well as by a pressure sensitive adhesive. The present invention, on the other hand, concerns application of a stick-on tattoo to a shoe. Because a stick-on tattoo is used in the present invention, no frame or adhesive generally is required. As a result, the shoe owner often can be more flexible as to where he or she places the tattoo on the shoe. In addition, it is believed that a tattoo often can be more easily initially applied and then subsequently removed than the insert in Savoca, because the shoe owner need not be concerned with properly positioning the insert within the frame or attempting to remove the insert from the frame. These advantages are believed to be particularly important where the shoe owner is a small child who may not have the manual dexterity to cope with the frame in Savoca. In addition, because no adhesive is generally required in the present invention, the present invention often will be safer than the method used in Savoca.

As understood by Applicant, U.S. Patent 5,740,557 (Reid) is directed to a technique for attaching an emblem to articles of clothing using magnetic material. This is clearly quite different than attaching stick-on tattoos to shoes as in the present invention.

U.S. Patent 5,775,007 (Exposé) is understood to discuss a heel protector that includes a pouch for storing a polishing cloth. This too is believed to be quite different than applying stick-on tattoos to shoes as in the present invention.

U.S. Patent 5,566,477 (Mathis) appears to be directed to a removable shoelace cover which attaches to a shoe using velcro strips. The shoelace cover in Mathis can be imprinted with team logos or other designs. However, this is also believed to be very different from the use stick-on tattoos in the present invention.

U.S. Patent 5,800,900 (Mitchell) discusses a patch which is insertable into a frame type of device on an article of clothing or footwear. As understood by Applicant, in Mitchell the patch is held in place by means of an overlapping lip and by velcro. Thus, Mitchell's technique is believed to be significantly different than that of the present invention. Moreover, because Mitchell uses a frame, Mitchell is believed to suffer from the same disadvantages as discussed above in connection with Savoca.

U.S. Patent 5,673,501 (Mathews) discusses a shoe which includes snap components so that ornamental articles can be snapped onto the shoe. Once again, this technique is believed to be significantly different than that of the present invention.

For instance, because the articles that are snapped onto the shoe are likely to protrude, they probably are more likely to be dislodged than the stick-on tattoos of the present invention.

As understood by Applicant, U.S. Patent 5,367,795 (Iverson) discusses a technique for manufacturing a shoe having an individualized display area. It appears that in Iverson, however, a panel that includes the display area is permanently attached to the shoe using stitching or adhesive. This is believed to be quite different from the present invention, which utilizes removable stick-on tattoos. In fact, a main advantage of the present invention is that the tattoos can be easily removed and replaced.

U.S. Patent 5,209,000 (Rowland) is understood to describe an attachment that is attached to a shoe by lacing shoelaces through slots in the attachment. It is noted that Rowland's attachments can be imprinted with team insignia or other designs. Even so, this technique is believed to be quite different than attaching stick-on tattoos to a shoe. For instance, although Rowland's attachment is removable, it appears that it generally can only be attached at a single position on the shoe.

U.S. Patent 5,136,726 (Kellin) is understood to discuss an article of clothing having a surface which is made of a stretchable material having a number of loop elements so that ornamental objects having hook elements on their surfaces can be attached to the article of clothing. In other words, Kellin appears to discuss

attaching ornamental objects to an article of clothing using velcro materials. This is believed to be quite different than attaching stick-on tattoos to shoes.

U.S. Patent 3,564,736 (Cunningham) appears to concern a shoe with a frame for holding a decorative patch of cloth. As understood by Applicant, Cunningham secures that patch of cloth within the frame by using a patch of resilient plastic which also fits within the frame and, in some cases, also by using velcro. Accordingly, Cunningham is believed to be very different from the present invention's use of stick-on tattoos.

The computerized search turned up the attached list of patents. Of the patents listed, only numbers 3, 15 and 16 appeared to be relevant. Number 3 has been discussed above. The following discussion pertains to numbers 15 and 16, of which copies are attached.

U.S. Patent 4,715,094 (Herdman) appears to be directed to device which clamps onto shoelaces and which has the purpose of preventing a shoelace from becoming untied. Thus, Herdman is believed to be very different from the present invention.

U.S. Patent 4,597,198 (Schweitzer) appears to be directed to an ornamental attachment having a support member on its non-ornamental side. As understood by Applicant, Schweitzer's ornamental attachment is attached to a shoe by

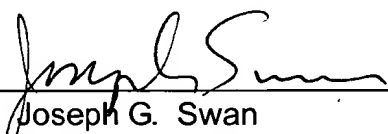
lacing the shoelaces through the support member. Accordingly, Schweitzer also is believed to be very different than the present invention.

Thus, although certain of the art which turned up in the search concerns decoration of shoes, none of the applied art appears to pertain to using stick-on tattoos on shoes in any manner, much less specifically as claimed. Accordingly, the present invention is believed to be allowable over the above-referenced art.

Attached is a check for \$130.00 as required under 37 C.F.R. 1.17(i) for a Petition to Make Special. In view of this submission and the accompanying check, all the requirements of M.P.E.P. §708.02 VIII are believed to be satisfied. Accordingly, Applicant respectfully requests that the accompanying Patent Application be made special and therefore accorded expedited examination.

Respectfully submitted,
MITCHELL, SILBERBERG & KNUPP LLP

Dated: March 15, 1999

By 
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Registration No. 41,338

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